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10/579,048	05/09/2006	Minerva M. Yeung	42P17842	6284
45209	7590	12/29/2009	EXAMINER	
INTEL/BSTZ			LAM, VINH TANG	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP			ART UNIT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,048

Applicant(s)

YEUNG ET AL.

Examiner

VINH T. LAM

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims **1, 10, and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation of Claims **1, 10, and 19** "...pre-existing traditional printed material ..." is not clear.

What does "...pre-existing..." mean?

What are the differences between pre-existing traditional printed material in electronic books disclosed in the application [0018] and the reference's electronic books?

To further advance prosecution, the Examiner interprets "...pre-existing traditional printed material ..." as a book, magazine, or article with printed material at the point of purchase.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1-5**, **8-14**, and **17-22** are rejected under 35 U.S.C. 102(b) as being anticipated by **Ohara et al. (US Patent No. 5739814)**.

Regarding Claims **1** and **10**, (currently amended) **Ohara et al.** teach a computer-implemented method of correlating and a non-transitory computer readable storage medium having a plurality of machine accessible instructions stored thereon, wherein when the instructions are executed by a processor, the instructions cause the processor to correlate respectively, pre-existing traditional printed material to a response produced by a computer system comprising:

defining an object on a page (i.e. **indicia**, Col. **4**, Ln. **63-66**, FIG. **2**) of the traditional printed material (i.e. pages or sheets in the **book**, Col. **7**, Ln. **5**; or **printed data**; Col. **7**, Ln. **17-19**); and

link a position (Col. **7**, Ln. **26-34**, FIGs. **5 & 6**; Col. **7**, Ln. **44-47**) of the object on the page, and a related response (Col. **7**, Ln. **47-51**, FIG. **2**) to be performed by the computer system, wherein the position of the object on the page corresponds to a physical position in the page of the pre-existing printed material (Col. **3**, Ln. **20-32**) which is identified by the computer system when the pre-existing printer material has been placed in a printed material holder (i.e. **cover**, Col. **4**, Ln. **56-58**, Col. **7**, Ln. **27-34**, FIGs. **5 & 6**; Col. **7**, Ln. **44-47**, FIG. **9**) by a user (Col. **5**, Ln. **5-8**, FIG. **9**), the printed material holder being coupled to the computer system (Col. **4**, Ln. **58-62**, FIG. **2**), and wherein the position on the page is defined by a relative position of the traditional

printed material to a known physical location of the printed material holder (Col. 7, Ln. **27-34**, FIGs. **5 & 6**; Col. 7, Ln. **44-47**, FIG. **9**).

Regarding Claims **2** and **11**, (original/currently amended) **Ohara et al.** teach the computer-implemented method of claim 1 and the non-transitory medium of claim 10 respectively, wherein the response comprises at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing.

Regarding Claims **3** and **12**, (original/currently amended) the computer-implemented method of claim 2 and the non-transitory medium of claim 11 respectively, further comprising (instructions for (Claim 11)):

generating a multimedia database (Col. 7, Ln. **39-41**, FIG. **9**) to store digital multimedia content including at least one of audio content, video content, image content (Col. 7, Ln. **34-37**, FIG. **9**), and text content (i.e. pages or sheets in the book, Col. 7, Ln. **5**; or printed data; Col. 7, Ln. **17-19**);

a printed material content database to store positional information about objects on the pages and linkage information between the objects (Col. 7, Ln. **27-34**, FIGs. **5 & 6**; Col. 7, Ln. **44-47**, FIG. **9**) and at least one of the multimedia contents and actions (Col. 7, Ln. **34-55**, FIG. **9**);

and an action library (i.e. ROM **16**, Col. 7, Ln. **39-41**, FIG. **9**) to store directives (i.e. **signals** and **data**, Col. 7, Ln. **39-41**, Ln. **45-51**, FIG. **9**) for actions to be performed on the computer system.

Regarding Claims **4** and **13**, (original/currently amended) **Ohara et al.** teach the computer-implemented method of claim 2 and the non-transitory medium of claim 11 respectively, wherein (instructions for (Claim 13)) defining the object on the page comprises (instructions for (Claim 13)) using an electronic pen to outline boundaries of the object on the page (Col. 7, Ln. 52-54, FIG. 9).

Regarding Claims **5** and **14**, (original/currently amended) **Ohara et al.** teach the computer-implemented method of claim 2 and the non-transitory medium of claim 11 respectively, wherein (instructions for (Claim 14)) defining the object on the page comprises (instructions for (Claim 14)) using an electronic pen to select key points on the boundary of the object on the page (i.e. inherent; Col. 7, Ln. 20-34, FIGs. 5 & 6).

Regarding Claims **8** and **17**, (original/currently amended) **Ohara et al.** teach the computer-implemented method of claim 2 and the non-transitory medium of claim 11 respectively, wherein the printed material comprises a traditional paper book (i.e. pages or sheets in the book, Col. 7, Ln. 5; or printed data; Col. 7, Ln. 17-19).

Regarding Claims **9** and **18**, (original/currently amended) **Ohara et al.** teach the computer-implemented method of claim 2 the non-transitory medium of claim 11 respectively, wherein the printed material comprises material generated by a user (i.e. drawing, Col. 5, Ln. 27-31).

Regarding Claim **19**, (currently amended) **Ohara et al.** teach an apparatus for associating a selected object on any pre-existing printed material to a valid response provided by a computer system comprising:

a pointing device (i.e. pen **24**; Col. **7**, Ln. **54**, FIG. **9**) to determine a position (Col. **7**, Ln. **29-34**, FIG. **9**) on the pre-existing printed material (i.e. pages or sheets in the book, Col. **7**, Ln. **5**; or printed data; Col. **7**, Ln. **17-19**), wherein the pre-existing printed material is to be placed on a printed material holder (i.e. **cover**, Col. **4**, Ln. **56-58**, Col. **7**, Ln. **27-34**, FIGs. **5 & 6**; Col. **7**, Ln. **44-47**, FIG. **9**) by a user (Col. **5**, Ln. **5-8**, FIG. **9**), and wherein the position on the pre-existing printed material is defined by a relative position of the printed material (Col. **3**, Ln. **20-32**) to a known physical location of the printed material holder (Col. **7**, Ln. **27-34**, FIGs. **5 & 6**; Col. **7**, Ln. **44-47**, FIG. **9**);

a communicating device coupled to the printed material holder to transmit the position to the computer system (Col. **7**, Ln. **41-43**, FIG. **9**);

a maker (i.e. **areas**, Col. **7**, Ln. **54-59**, FIG. **9**) component to define an object on a page (i.e. **indicia**, Col. **4**, Ln. **63-66**, FIG. **2**) of the pre-existing printed material (Col. **7**, Ln. **54-59**, FIG. **9**); and

to link a position (Col. **7**, Ln. **26-34**, FIGs. **5 & 6**; Col. **7**, Ln. **44-47**) of the object on the page and a related response (Col. **7**, Ln. **47-51**, FIG. **2**) to be performed by the computer system; and

a player component (i.e. **ROM 16**, Col. **7**, Ln. **39-41**, FIG. **9**) to correlate the pointed position to selected content associated with the pre-existing printed material, the selected content being accessible by the computer system (Col. **7**, Ln. **52-61**, FIG. **9**); and

to provide a valid response (Col. **7**, Ln. **47-51**, FIG. **2**) to the user based at least in part on the pointed position and the correlated content, wherein the valid response

includes at least one of rendering audio content, rendering video content, rendering image content, rendering text content, and performing an action by the computer system (Col. 7, Ln. 35-38, Ln. 45-51, FIG. 9).

Regarding Claim 20, (currently amended) **Ohara et al.** teach the apparatus of claim 19, wherein the pointing device comprises an electronic pen (Col. 7, Ln. 54-59, FIG. 9).

Regarding Claim 21, (currently amended) **Ohara et al.** teach the apparatus of claim 19, further comprising a multimedia database to store digital multimedia content (Col. 7, Ln. 45-49, FIG. 9), a printed material content database to store positional information about objects on the pages (Col. 7, Ln. 54-59, FIG. 9) and linkage information between the objects and at least one of the multimedia contents and actions, and an action library to store directives for actions to be performed on the system (Col. 7, Ln. 45-49, FIG. 9).

Regarding Claim 22, (currently amended) **Ohara et al.** teach the apparatus of claim 19, wherein the pre-existing printed material comprises a traditional paper book (i.e. pages or sheets in the book, Col. 7, Ln. 5; or printed data; Col. 7, Ln. 17-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **6-7** and **15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ohara et al. (US Patent No. 5739814)**.

Regarding Claims **6** and **15**, (original/currently amended) **Ohara et al.** teach the computer-implemented method of claim 2 and the non-transitory medium of claim 11 respectively.

Although **Ohara et al.** do not teach that (instructions for (Claim 15)) defining the object on the page comprises (instructions for (Claim 15)) using a mouse to manipulate a graphical object on a display to encapsulate the boundary of the object on the page as displayed on the display.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace **Ohara et al.'s** touch pen with a mouse to manipulate a graphical object on a display to encapsulate the boundary of the object on the page as displayed on the display *for the benefit of* utilizing an alternative input device.

Regarding Claims **7** and **16**, (original/currently amended) **Ohara et al.** teach the computer-implemented method of claim 2 and the non-transitory medium of claim 11 respectively.

Although **Ohara et al.** do not teach (instructions for (Claim 16)) defining the object on the page comprises (instructions for (Claim 16)) using a mouse to select key points on the boundary of the object on the page as displayed on a display.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace **Ohara et al.'s** touch pen with a mouse to select key points on the boundary of the object on the page as displayed on a display *for the benefit* of utilizing an alternative input device.

Response to Arguments/Amendments/Remarks

4. Applicant's arguments, see Page(s) 7-8 filed 10/12/2009, with respect to 35 U.S.C. §101, and §112 2ND ¶, have been fully considered and are persuasive. The Rejections under U.S.C. §101, and §112 2ND ¶ have been withdrawn.
5. Applicant's arguments, see Page(s) 7-8 filed 10/12/2009, with respect to the Advisory Action have been fully considered and are ***NOT*** persuasive.

First of all, applicant argues that "*...the printed material is not part of the apparatus, but is to be used with the apparatus...*". However, the Examiner respectfully disagrees because there is **no such limitation in the claim**. It is ***irrelevant*** that "*... an ordinary person, whether skilled in the art or not, will understand from the reading of Applicants' Specification...*", it is **claims' limitations** recite the novel and patentable products and/or methods over the prior arts.

Finally, USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims

must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Conclusion

The prior art(s) made of record and not relied upon (is)/are considered pertinent to applicant's disclosure: Zetts; John M. (US Patent/PGPub. No. 5404458).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH T. LAM whose telephone number is (571)270-3704. The examiner can normally be reached on M-F (7:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amare Mengistu can be reached on (571) 272-7674. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Lam/
Examiner, Art Unit 2629

/Amare Mengistu/
Supervisory Patent Examiner, Art Unit 2629